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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,938	07/11/2003	Gary A. Rocheleau	239580US-25 CONT	3027
22850	7590	12/09/2005		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GILBERT, SAMUEL G	
			ART UNIT	PAPER NUMBER
			3735	
DATE MAILED: 12/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/616,938	<b>Applicant(s)</b> ROCHELEAU ET AL.	
	<b>Examiner</b> Samuel G. Gilbert	<b>Art Unit</b> 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,8,9 and 20 is/are allowed.
- 6) ☒ Claim(s) 7,10-16 and 18 is/are rejected.
- 7) ☒ Claim(s) 17 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7, 11-13, 16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kammerer et al (2002/0077526).

Applicant's attention is invited to figures 3A through 4I and the respective written description. Element -110- is an elongate needle, element -112- is a coupler, element -10- is a sling association needle. The sling -12- is connected to the sling associated needle at the proximal end of the sling associated needle by sling association means shown in figure 4a connecting the sling -12- to the sling associated needles -10a- and -10b-.

The applicant has priority for a sling associated needle back to US Patent Application 10/005,837, filed 11/9/2001 while Kammerer et al was filed 6/4/2001.

Claim 13 – complementary internal surfaces are shown in figure 3d.

Claims 10 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers (3,238,491). The claims require only a coupler for use in an incontinence

procedure and the preamble and body of the claims set forth other elements used in the procedure however the claim is directed only to subcombination of the coupler.

Therefore the claim is being construed as a subcombination claim that does not require the needle or the sling but merely a coupler that needs to be capable of being used with the needle and sling as claimed.

Claims 10 and 15 – the applicant's attention is invited to Figure 3 and chuck-38-. Element –39- forms a body having an axis with a first end shown at reference number –40- and a second end shown at reference number –56-. A lumen is shown inside element –39- the lumen is capable of receiving a needle in the same manner as element –50-. The examiner is taking threaded bore –54- and plug –56- as the sling association means which is capable of connecting a sling to the coupler.

Claim 14 – the conical shape of jaws –58- and –59- and chuck –38- inherently provide a separation force of at least about 15 pounds.

Claim 16 – threaded portion –54- is capable of being axially threaded onto a threaded needle connected to a sling. Again the claim is only directed to the subcombination of the coupler.

With regard to claims 17 19 and 20 the examiner is taking the claim to be directed to a connector wherein the connector includes a sling fixedly attached thereto.

***Allowable Subject Matter***

Claims 1-6, 8, 9, and 20 are allowed.

Claims 17 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 9/12/2005 have been fully considered but they are not persuasive. With regard to the arguments directed to the rejections based on Rogers(3,238,491) the newly cited limitations of the "sling association means have been discussed above. Further the applicant argues that the antenna of Rogers does not meet the use limitations in the preamble of the rejected claims. In response to applicant's argument a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case the coupler of Rogers is capable of being connected to a needle. Further, the rejected claims do not require a combination of a coupler and a needle only the subcombination of the coupler, therefore the examiner has not set forth that the antenna of Rogers is a "needle" but rather that the coupler of Roger is capable of connecting to a needle in the same manner as the antenna set forth. The applicant has further argued that Rogers patent is directed to subject matter that is prima facie unrelated to the technology of the present invention. However because the Rogers patent anticipates the rejected claims the relation of the technology is irrelevant.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam can be reached on 571-272-4737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Samuel G. Gilbert  
Primary Examiner  
Art Unit 3735